

REMARKS/ARGUMENTS

In response to the Restriction Requirement, applicant elects with traverse Group 22 (claims 44-61) and SEQ ID NO: 34. In response to the further restriction requirement, applicant elects the KIF11 gene. With regard to the species election, applicant elects siRNA.

Applicant respectfully traverses the election of a single siRNA target sequence from the group consisting of SEQ ID NO: 32, 33, 34, 35, 36, 37, and 108. In the Office Action, the Examiner asserts that each sequence presents a structurally and functionally distinct invention, not a species.

Applicant respectfully disagrees. At least SEQ ID Nos: 32, 33, and 34 should be examined in a single application for the following reasons. Unity of invention exists when there is a technical relationship among the claimed inventions involving one or more of the same or corresponding special technical features. MPEP §1850. MPEP §1850, III provides illustrations of three particular situations for determining unity of invention. One such situation is "Markush practice". In this situation, the requirement of the same or corresponding special technical features is considered to be met when the alternatives are of "a similar nature." The MPEP further notes that when the Markush grouping is for alternatives of chemical compounds, they shall be regarded as being of "a similar nature" where the following criteria are fulfilled:

(A) All alternatives have a common property or activity; and

(B)(1) A common structure is present; *or*

(B)(2) In cases where the common structure cannot be the unifying criteria, *all alternatives belong to a recognized class of chemical compounds* in the art to which the invention pertains. (emphasis added)

The requirement of being in a "recognized class of chemical compounds" is met if there is an expectation from the knowledge in the art that members of the class "will behave in the same way in the context of the claimed invention," *i.e.*, each member "could be substituted one for the other, with the expectation that the same intended result would be achieved."

In the context of the present invention, SEQ ID Nos: 32, 33, 34, 35, 36, 37, and 108 correspond to "alternatives" in a Markush claim, and should be treated as set forth in MPEP

1850. In addition, SEQ ID Nos: 32, 33, and 34 are of a “similar nature” as defined above, for the following reasons.

(A) SEQ ID Nos: 32, 33, and 34 are all targets for siRNA against the KIF11 gene. As is apparent from Fig. 8 of the present application, expression of KIF11 mRNA was suppressed by siRNA targeting SEQ ID Nos: 32, 33, and 34. Thus, SEQ ID Nos: 32, 33, and 34 have a common property and activity.

(B)(2) The nucleotide sequences of SEQ ID Nos: 32, 33, and 34, all belong to a recognized class of chemical compounds (nucleic acid molecules). Moreover, as noted above, the specification demonstrates that each sequence serves as a target of siRNA that suppresses the expression of KIF11 mRNA. Each sequence can be substituted one for the other, with the expectation that the same intended result would be achieved. Thus, SEQ ID Nos: 32, 33, and 34 clearly belong to a recognized class of chemical compounds in the art to which the invention pertains.

Applicants respectfully submits that SEQ ID Nos: 32, 33, and 34 share the same or corresponding special technical features. and thus, fulfill the requirement of unity of invention. Reconsideration of the restriction between SEQ ID Nos: 32, 33, and 34 is respectfully requested.

Appl. No. 10/593,842
Amdt. dated November 26, 2008
Reply to Office Action of October 30, 2008

PATENT

CONCLUSION

If a telephone conference would expedite prosecution of this application, the Examiner is invited to telephone the undersigned at 415-576-0200.

Respectfully submitted,

/Kevin Bastian/

Kevin Bastian
Reg. No. 34,774

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 415-576-0200
Fax: 415-576-0300
Attachments
KLB:dlh
61703698 v1